

**RESPONSE UNDER 37 C.F.R. 1.116
EXPEDITED PROCEDURE
EXAMINING GROUP 1634**

S/N 09/125,953

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	FODSTAD et al.	Examiner:	Sisson, B.
Serial No.:	09/125,953	Group Art Unit:	1634
Filed:	December 10, 1998	Docket No.:	7885.56USWO
Title:	IMMUNO-MAGNETIC CELL SEPARATION USED IN IDENTIFICATION OF GENES ASSOCIATED WITH SITE- PREFERENCED CANCER METASTASIS FORMATION		

CERTIFICATE UNDER 37 CFR 1.6: The undersigned hereby certifies that this correspondence is being transmitted via facsimile to: TC1600, Commissioner for Patents, Washington, D.C. 20231 on March 4, 2003.

By: Victoria Hanson
Name: Victoria Hanson

PETITION UNDER 37 C.F.R. § 1.181

Box AF
Commissioner for Patents
Washington, D.C. 20231

VIA FACSIMILE
TC1600
703-872-9307

Dear Sir:

PETITION TO WITHDRAW FINALITY

Applicant hereby petitions the Commissioner to withdraw the finality of the pending Office Action and enter the attached response. The facts of the case are as follows:

1. An After Final Amendment and Declaration of the inventor was filed July 26, 2002.
2. An Advisory Action was mailed August 13, 2002 stating the amendment would not be entered.
3. A Request for Continued Examination (RCE) was filed August 26, 2002, requesting the After Final Amendment and Declaration be entered.
4. On October 3, 2002 a Final Office Action was mailed. Under paragraph #1, the Examiner stated that the finality of the previous Office Action was withdrawn and the submission filed August 26, 2002 had been entered.

However, in the pending Final Office Action mailed October 3, 2002, the Examiner has not considered the claims as amended, has not fully responded to Applicants' arguments, has not considered the declaration, and has made the first action

after the RCE final. The Examiner acknowledges receipt of the signed declaration, but asserts it was not timely because it is not directed solely to new issues raised in the non-final office action of May 4, 2001. Applicants respectfully disagree.

Paragraph #1 of the Office Action states that the finality of the previous Office Action was withdrawn, and the amendment and declaration filed on August 26, 2002 was entered. With the finality of the office action withdrawn, the declaration was effectively filed before a final action. MPEP 716.01 states that affidavits, declarations and other evidence traversing rejections "are considered timely if submitted: (1) prior to a final rejection". The requirement that a declaration be directed solely to a new ground of rejection or requirement applies to declarations filed after a final rejection when the new ground of rejection was made in the final rejection. In the instant case, the declaration was filed with the RCE and thus before final rejection. Applicants respectfully request the Commissioner direct the Examiner to consider the timely-filed declaration, and if the declaration is deemed insufficient to overcome the enablement rejection, to please specifically explain why the evidence is insufficient.

Conclusion

In view of the RCE filed August 26, 2002, Applicants submit that the declaration was timely filed before final action and must be fully considered by the Examiner. Because the declaration has not been considered, Applicants respectfully submit that the finality of the Office Action is premature and should be withdrawn. Applicants request reconsideration of the application in view of the declaration and amendments filed with the RCE, and the response filed herewith.

Respectfully submitted,

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Date: March 4, 2003



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